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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/090,184	03/01/2002	Robert Lee Adams	ADAB101	4735
21658	7590	12/15/2006	EXAMINER	
DYKAS, SHAVER & NIPPER, LLP P.O. BOX 877 BOISE, ID 83701-0877			DASS, HARISH T	
			ART UNIT	PAPER NUMBER
			3693	

DATE MAILED: 12/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/090,184

Applicant(s)

ADAMS, ROBERT LEE

Examiner

Harish T. Dass

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 10-14 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/1/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-9 are drawn to method for granting advances and loans based upon an anticipated income tax refund prior to the preparation of the income tax return 705, subclass 38.
- II. Claim 10-13 are drawn to method for providing pre-purchased tax preparer services in conjunction with a system for granting loans, classified in class 705, subclass 38.
- III. Claim 14 is drawn to method for operating a self-funding, instant loan, qualification, issuance and collection program based upon an anticipated income tax refund, classified in class 705, subclass 38.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because I is directed granting advances, and invention II is directed to providing pre-purchased tax preparer services. The subcombination has separate utility such as integrating data.

Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because I is directed to method for granting advances, and invention III is directed to providing pre-purchased tax preparer services. The subcombination has separate utility such as integrating data.

Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because II is directed to providing pre-purchased tax preparer services, and invention III is directed to providing pre-purchased tax preparer services. The subcombination has separate utility such as integrating data.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Per Attorney Stephen Nipper phone message 12/06/06, the applicant elected claims 1-9 (Group I) to be prosecuted. Affirmation of this election must be made by applicant in replying to this Office action. Groups II and Group III (Claims 3-5) are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilson (US 7,127,425) in view of Anderson et al. (US 7,010,507).

Re. Claim 1, Wilson discloses qualifying a client for a loan [col. 1 lines 27-31 – see “By doing trend analysis ...” ],

verifying that adequate funds are anticipated from said anticipated income tax return to process said loan [col. 1 lines 38-40; col. 2 lines 26-33],

preparing an income tax return including compiling and preparing proper documentation [col. 2 line 51 to col. 3 line 25], and

filing said income tax return with proper documentation when completed [col. 1 lines 21-22 – see prepare and electronically ...],

receiving said income tax refund into a receiving account [col. 6 lines 25-56]. Wilson explicitly does not explicitly disclose completing an application for said loan, transmitting said application to a central processing center, verifying that said client has no loans set against said anticipated income tax refund, obtaining acceptance of said loan from the client, transferring an amount of money equal to said loan to said client, recovering said amount of money together with at least one fee from said receiving account, and returning any remaining amounts of money belonging to said client to said client.

However, verifying that said client has no loans set against said anticipated income tax refund, and obtaining acceptance of said loan from the client are known. For example, in application for a loan (equity loan, mortgage, etc.) using internet or fax (electronically) applicant files a signed application form (signing means accepting all the conditions stated in application form) and all applicant's relevant information and transmits the information to the lender, the lender reviews the information and after verification and obtains credit report for outstanding loans, calculates the eligibility and the amount of loan the applicant is qualified, after approval, the amount is transferred to applicant (applicant's account in case of home equity loan). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Wilson and include the above step to allow the lender to proceed for approval processing loan application and transferring the fund to client.

Anderson discloses completing an application for said loan [col. 1 lines 20-40], recovering said amount of money together with at least one fee from said receiving

account [col. 1 lines 45-51; col. 2 lines 24-61], and transferring an amount of money equal to said loan to said client [col. 1 lines col. 1 lines 20-40 – issue an advance payment], and transmitting said application to a central processing center and returning any remaining amounts of money belonging to said client [col. 2 lines 45-61] to provide a data processing system for the authorization and fast available use of tax refund amount by way of tax filers account. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Wilson and include the above steps disclosed by Anderson, to provide a system for tax refund loan to client who need the money during holidays before filing tax return.

Re. Claims 2-4 and 7-8, Wilson discloses tax refund is assigned to tax preparation company [col. 1 lines 30-35]. Anderson further discloses wherein the application for the loan is completed using a computer processing program [col. 2 lines 45-61] and transmitting the application is done electronically, and transmitting the application is done via a globally accessible computer network and wherein said loan is dispersed from a loan dispersing account maintained by a financial services company other than a banking institution [col. 3 lines 34-54; col. 1 lines col. 1 lines 20-40 – CompuServe and credit card bank], and wherein the financial services company is a tax preparation organization [col. 3 lines 44-47 – H&R Block]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Wilson and include the above steps disclosed by Anderson, to provide a system for tax refund loan to client who need the money fast.

Re. Claims 5-6, Wilson discloses wherein the step of obtaining acceptance of the loan includes printing an acceptance form and obtaining a signature from said client on said form [col. 1 lines 31-33] and wherein said loan is dispersed from a loan dispersing account maintained by a banking institution, said banking institution also the location where the receiving account is located [col. 3 lines 39-60].

Re. Claim 9, Wilson discloses agreement between the taxpayer and tax preparation company (wherein the account is funded by receipts from a contractual agreement) [col. 1 lines 30-35]. Wilson or Anderson does not explicitly disclose whereby a tax preparer contracts to provide a set of designated services in the event of a review by the Internal Revenue Service. However, this is business choice. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Wilson and Anderson and include the above step, to allow the service provider provide extra service and improve its bottom line.

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Applicant is required under 37 CFR ' 1.111 (c) to consider the references fully when responding to this action.

US 5,870,721 (Norris) discloses a method and apparatus for closed loop processing of a loan application, including completion of the application, underwriting,



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and transferring of funds. The term "closed loop" means that all the steps involved in loan processing, including the steps of transferring the funds to the borrower and arranging for repayment as well as completing the loan application and underwriting it, can be done without human intervention. The apparatus uses a computer capability and a communications link, plus other electronic communications equipment, to enable the complete, automated processing of the application, namely, the exchange of information with the applicant preferably using human voice recognition equipment, the underwriting, meaning the evaluation and approval, of the loan, plus initiating electronic transfer of funds from a source of funds to the deposit account designated by the applicant and automatic withdrawals from the applicant's account to repay the loan.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Harish T. Dass whose telephone number is 571-272-6793. The examiner can normally be reached on 8:00 AM to 4:50 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Harish T Dass  
Examiner  
Art Unit 3693

*Harish T Dass*

12/7/06